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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

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| IN RE APPLICATION OF | : |
| ROBERT KUHLMANN, ET AL. | : EXAMINER: JOHNSON, E. M. |
| SERIAL NO: 09/991,640 | : |
| FILED: NOVEMBER 26, 2001 | : GROUP ART UNIT: 1754 |
| FOR: HIGH-STRUCTURE PRECIPITATED SILICAS | : |

# REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is a Reply Brief, in reply to the Examiner's Answer dated December 23, 2004 (Answer).

Appellants acknowledge the Examiner's allowance of Claims 15-16 (Answer at 2).[1] Appellants also acknowledge the Examiner's withdrawal of the rejection listed under Issue (C) in the Appeal Brief (Answer at 7). Thus, the only issue remaining is whether Claims 1-14 and 17 are unpatentable under 35 U.S.C. § 103(a) over U.S. 4,495,167 (Nauroth et al). Appellants maintain the arguments made in the Appeal Brief. The following is in reply to the Examiner's Response to Argument (Answer at 5-6).

[1] While the Answer responds to arguments made about Claims 15 and 16 in the Appeal Brief (Answer at 6-7), Claims 15 and 16 are never stated to be rejected in the Answer. The Examiner confirmed, in a telephone conversation with the undersigned attorney on January 12, 2005, that Claims 15 and 16 are indeed allowed.

The Examiner finds that it is unclear which of Appellants' representations to the Office is correct -- that made in Nauroth et al or that made in the present application, noting that they are both commonly assigned. The Examiner also appears to be concerned that Nauroth et al, which has already expired, was based on incorrect disclosure.

In reply, Appellants' assignee has represented in this record that it is not able to explain why the data shown in Table 2 of Nauroth et al, particularly Example 1, indicates a DBP number of 380 g/100g and has further represented that it is very unlikely that a silica exhibiting a DBP number greater than 380 g/100g can be produced by the process disclosed in Nauroth et al, although the assignee cannot guarantee that it is impossible. Nevertheless, this issue should now be moot, because the claims on appeal requires that the DBP be greater than 380 g/100g, while Nauroth et al does not disclose a higher DBP.

The Examiner finds that "there is nothing on the record indicating that some other condition could have been present that caused the alleged different result. Therefore, the disclosed DBP absorption value would obviously, to one of ordinary skill, include at least some infinitesimal values above 380 with a reasonable expectation of achieving a similarly favorable result as that within the disclosed range" (Answer at 5-6).

In reply, Appellants have already pointed out that Nauroth et al does not enable a DBP absorption value as high as 380. It follows that one skilled in the art would also not be enabled by Nauroth et al to obtain a DBP absorption value infinitesimally greater than 380. Moreover, if there was some other condition that could have produced the 380 result in Nauroth et al, it is not disclosed therein. Nevertheless, as discussed in the Appeal Brief,

Reference Example 1 herein purports to reproduce the example of Nauroth et al described as producing a DBP absorption value of 380, yet obtained a DBP absorption value of only 355.

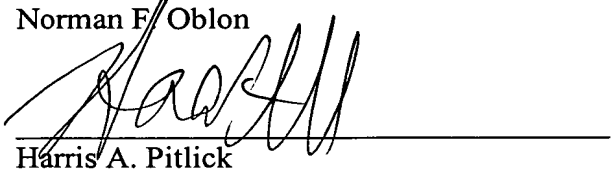
In response to Appellants' argument regarding Nauroth et al's disclosure of solids content and lack of recognition of its significance, the Examiner finds that "[t]his is not persuasive because one of ordinary skill would not require a specific definition of the term 'about', as Applicant appears to suggest, to understand that a range around the disclosed data point is being referred to." The Examiner thus continues to find that Nauroth et al's disclosure of "about 46 g/l" suggests "a range of acceptable values at least including 42 g/l."

In reply, Appellants repeat that the disclosure of the term "about 46 g/l", with no description of the definition of "about", no description of a solids content other than about 46 g/l, and no description of any significance of solids content, does not suggest a range that would include 42 g/l.

For all the above reasons, it is respectfully requested that the rejection over Nauroth et al be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon



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